

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed July 11, 2007. Claims 1, 3, 6, and 8-10 are pending in this Application and Claims 2, 4, 5, and 7 were previously cancelled without prejudice of disclaimer. Claims 1, 3, 6, and 8-10 stand rejected under 35 U.S.C. § 102(b) and Claims 1 and 3 stand rejected under § 112, second paragraph. Applicants have amended Claim 1 to correct a typographical error and have amended Claim 6 to further define features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1 and 3 were rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner alleged that Claim 1 recites "a conical nozzle needed tip" in line 9 which appears to be a double inclusion of the "conical nozzle needle tip recited in line 7. Applicants have amended Claim 1 to overcome this rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, and full allowance of Claims 1 and 3, as amended.

Rejections under 35 U.S.C. § 102

Claims 1, 3, 6, and 8 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,899,389 issued to Arpad M. Pataki et al. ("Pataki"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,470,548 issued to Shoji Ushimura ("Ushimura"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,982,901 issued to Volker Holzgrefe ("901-Holzgrefe"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,012,981 issued to Volker Holzgrefe et al. ("981-Holzgrefe"). Applicants respectfully

traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

As an initial matter, Applicants reiterate by reference thereto their arguments and comments set forth in Applicants' Response dated January 2, 2007 ("Applicants' Previous Response"), and supplement such arguments with the additional comments set forth below. Applicants' decision not to repeat any such arguments below is not a concession that any such arguments are incorrect, invalid, or without merit.

A. The Form of the Examiner's Rejections under 35 U.S.C. § 102(b) are Improper Because the Examiner Failed to cite Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe with Sufficient Specificity under 35 U.S.C. § 132 to Allow Applicants to Adequately Respond to the Rejections

The Applicants yet again note that the form of the Examiner's rejections under 35 U.S.C. § 102(b) are improper because the Examiner failed to cite Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe properly and with sufficient specificity under 35 U.S.C. § 132 and 37 C.F.R. § 1.104 to allow Applicants to adequately respond to the rejections. The Examiner's explanation for rejection of Claims 1, 3, 6 and 8-10 is insufficient under these statutes and regulations. For example, according to 35 U.S.C. § 132, the PTO must notify Applicants of the reasons for rejecting *each* claim (including dependent claims) and provide such information and references as may be useful in judging the propriety of continuing the prosecution. In addition to those arguments set forth in Applicants' Previous Response, a non-exhaustive list of examples of the Examiner's failure to reject claims with the specificity requires appears below:

- Claim 6 recites "a nozzle body having a nozzle body seat." To date, the Examiner has failed to identify those elements of the cited references the Examiner regards as "a nozzle body seat."
- Claim 6 also recites "a nozzle needle tightly guided in the nozzle body and incorporating a nozzle needle shaft and a nozzle needed seat." To date, the Examiner has failed to identify those elements of the cited references the Examiner regards as "a nozzle needle seat."

- Claim 6 also recites “a gap axially in height between the sealed seat and the nozzle needle shaft.” To date, the Examiner has failed to identify those elements of Ushimura, 901-Holzgreffe and 981-Holzgreffe that Examiner regards as a “gap.”
- Claim 6, prior to amendment herein, recited that “the gap is operable to hydraulically dampen movement of the nozzle needed seat toward the nozzle body seat.” To date, the Examiner has failed to identify those portions of the cited references, or any *extrinsic* evidence of record that indicates that any alleged gaps are “operable to hydraulically dampen movement of the nozzle needed seat toward the nozzle body seat.”

For at least these reasons, Applicants respectfully submit that the Examiner has failed to cite Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe properly and with sufficient specificity to allow Applicants to adequately respond to the rejections under 35 U.S.C. § 102. Thus, the Examiner has clearly failed to comply with 35 U.S.C. § 132. If the Examiner maintains rejections of the pending claims based on Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe, Applicants respectfully request that such rejections be sufficiently specific and included in a Non-Final Office Action, such that Applicants have an opportunity to adequately respond to *all* rejections (including rejections of dependent claims) based on Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe.

B. Claims 1, 3, 6, and 8-10 are Not Anticipated by Pataki, Ushimura, 901-Holzgreffe and 981-Holzgreffe

Assuming, *arguendo*, that the Examiner has set forth adequate reasons for rejection as contemplated by 35 U.S.C. § 132 (which the Applicants do not concede), rejected Claims 1, 3, 6 and 8-10 are not anticipated under 35 U.S.C. § 102(b). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, for the reasons set forth in Applicants' Previous Response and the additional reasons set forth below.

Claims 1 and 3

Independent Claim 1 recites, among other elements, a fuel injection valve that includes a nozzle needle with a nozzle needle seat that includes "the outer surface of the conical nozzle needle tip provided ***directly adjacent*** the frusto-conical body section of the nozzle needle wherein the outer surfaces of a conical nozzle needle tip and of the frusto-conical body section of the nozzle needle each have an included angle, the included angle of the conical needle tip having an included angle essentially the same as the included angle of the frusto-conical body section of the nozzle needle." In response to this argument, the Examiner states in the most recent Office Action:

[A]pplicant's cylindrical section 16 intervenes between conical nozzle top 10 and frusto-conical body section 24. Therefore, the term "directly adjacent" does not preclude intervening structures as used by applicant.

(Office Action, Page 5).

Examiner's response fails for numerous reasons. First, a plain reading of the term "directly adjacent" ***does preclude*** intervening structures. Otherwise, the Examiner is effectively reading the phrase "directly adjacent" out of Claim 1, as any other contrary interpretation is entirely consistent with the English language. If the Examiner's construction of the term "directly adjacent" were to prevail, one could say that the state of Maine is "directly adjacent" to the state of California. Second, Examiner's statement that "applicant's cylindrical section 16 intervenes between conical nozzle tip 10 and frusto-conical body section 24" completely ignores the embodiment set forth in Figure 4 of the Application, which depicts a nozzle needle tip 10 directly adjacent to frusto-conical body section 24, without any intervening elements.

Accordingly, for the reasons set forth above and in Applicants' Previous Response, Pataki does not teach all of the elements of Claim 1 and, therefore, cannot anticipate

Independent Claim 1 or Claim 3 that depends therefrom. Applicants request reconsideration, withdrawal of the rejection under 35 U.S.C. § 102(b) and full allowance of Claims 1 and 3.

Claims 6 and 8-10

Independent Claim 6 prior to amendment herein recited a fuel injection valve that includes a nozzle body including a nozzle body seat and a nozzle needle with a nozzle needle seat, with a gap formed between the nozzle needle and the nozzle body “such that the gap is operable to hydraulically dampen movement of the nozzle needle seat toward the nozzle body seat.” As noted in Applicants’ Previous Response, the cited references do not disclose providing a gap designed for dampening of the motion between the nozzle body and the nozzle needle. In the Office Action, the Examiner responds:

Regarding applicant’s argument that the prior art does not explicitly or inherently disclose that the gap is operable to hydraulically dampen the movement of the nozzle needle, the recitation merely requires the ability to so perform and does not constitute a positively recited limitation. Even so, the pressure acting on the gap surface would inherently provide a dampening function.

(Office Action, Page 6).

First, Applicants’ submit that Claim 6 does positively recite the limitation regarding the gap being functional to hydraulically dampen the movement of the nozzle needle seat toward the nozzle body seat. Nonetheless, in order to avoid further time and expense of obtaining patent protection, the Applicants’ have amended the limitation in question to recite “wherein the gap is implemented as an elongated recess between the nozzle needle and the nozzle body such that the gap is configured to hydraulically dampen movement of the nozzle needle seat toward the nozzle body seat,” in order to demonstrate the positive recitation of the functionality of the gap.

Second, Applicants’ again strenuously object to Examiner’s repeated attempts to reject the recited dampening function on grounds of inherency without providing any evidence of record to support the Examiner’s contentions that the cited references have the ability to operate in the manner claimed.

It is a well-settled principle of patent law that “[t]he fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic.” M.P.E.P. § 2112(IV), *citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Instead, to establish that a claim element is inherent in a prior art reference, *extrinsic* evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); M.P.E.P. § 2112(IV). Inherency, however, may not be established by probabilities or possibilities. *In re Robertson*, 169 F.3d at 745; M.P.E.P. § 2112(IV).

In spite of this bedrock principle of patent law, the Examiner maintains, despite any shred of evidence in any document of record in the present application, that the alleged gap present in each of the references has the ability to perform the dampening function. The Examiner has failed (despite the repeated protests of the Applicants) to provide proof (*e.g.*, references of record) to support the conclusion that the gaps purportedly disclosed in the cited references can perform the dampening function claimed by the Applicants. If the Examiner is relying upon personal knowledge, no affidavit has been provided. *See* M.P.E.P. § 2144.03 (setting forth the requirements of reliance of common knowledge in the art).

Accordingly, for the reasons set forth above and in Applicants’ Previous Response, the cited references do not disclose all of the elements of Independent Claim 6. Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 102(b) and full allowance of Claims 6 and Claims 8-10 that depend therefrom.

CONCLUSION

Applicant appreciates the Examiner's careful review of the application. Applicant has now made an earnest effort to place this case in condition for examination and allowance. For the foregoing reasons, Applicant respectfully requests reconsideration of the rejections and full allowance of Claims 1, 3, 6, and 8-10, as amended.

Applicants believe no fees are due, however the Commissioner is hereby authorized to charge any fees necessary to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Brian K. Prewitt
Registration No. 60,135

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SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2684
512.322.8383 (fax)